

REMARKS

Claims 1-3, 5, 6, 8, 9, 17 and 19-21 are pending in this application. Claim 7 has been cancelled. Claim 1 has been amended. Claim 21 has been added. Claims 1 and 17 are independent claims.

A. Claim Objection

In an Office action dated November 7, 2003, an objection was made to claim 1, since the claim contained a typographical error. In response, Applicants have amended line 1 of claim 1 to refer to "capability of a telephone," rather than to "a telephone=s capability." Thus, as required in the Office action, Applicants have corrected the error. Applicants have also reviewed the claims to ensure that no other errors exist. Reconsideration of the claims is requested.

B. Rejection under 35 U.S.C. 102

Applicants note with appreciation that the finality of the previous Office action was withdrawn. However, a new basis for rejection was cited. Specifically, all of the pending claims were rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Bentley et al. In response, Applicants have amended independent claim 1 to more clearly distinguish the claimed invention from the cited prior art. Additionally, claim 21 has been added. It is respectfully submitted that the pending claims are patentably distinguished from the teachings of Bentley et al.

Claim 1 has been amended to include the subject matter of claim 7, which is now cancelled. Amended claim 1 also states that the "recognizing step" from claim 7 is a step of recognizing that the "first call-related data received at the telephone is to be processed in order to provide a particular telephone function". Subsequently, the step of determining whether the first call-related data will be processed by the processor of the telephone or the processor of the computer is at least partially based on determining

whether the telephone has the processing capability to provide the particular function. Thus, in the method of claim 1, the telephone is enabled to perform telephone functions independently of the computer, but is reliant upon cooperation with the computer in performing the particular telephone function.

Added claim 21 states that the steps of (1) receiving call-related data at the telephone, (2) recognizing that the data requires further processing, (3) determining, using automated processing capabilities of the telephone, whether the data will be processed in the first processor resident in the telephone or in the second processor resident in the computer, and (4) processing the data in the telephone or the computer all occur during a single telephone call in which the call-related data is received.

Support for the amendment to claim 1 and the additional claim 21 may be found on page 4, lines 6-24 and page 7, lines 5-22 of the application as originally filed. For example, on page 4, it is stated that the telephone utilizes the increased sophistication of processing capacity of the computer to handle processing-intensive operations or processing overflow. A stated advantage of the invention is that the capability of a conventional desktop telephone can be extended by utilizing the relatively large processing capability of a nearby personal computer, as well as the large storage capacity of the computer. Similarly, on page 7 of the application as originally filed, it is stated that by enabling the telephone to utilize the processing capacity of the personal computer, the processing capability of the telephone is greatly expanded. The API (72) within the telephone typically utilizes the computer processor (54) to perform more intensive processing. Stated examples of telephone functionalities that may require extended processing capability are voice activated functions and voice pattern recognition. Where the voice data to be processed is the received "call-related data" of claim 17, all of the steps of independent claim 17 occur during a single telephone call in which the call-related data is received (claim 21).

1. Patentability of Amended Claim 1

To briefly state the standard, rejections under Section 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art, so that there is no material difference. In re Marshall, 198 USPQ 344 (CCPA 1978). In amended claim 1, the invention is described as including the step of at least partially basing a determination of which processor is to be used upon whether the telephone has the processing capability to provide the particular telephone function. Thus, the telephone is enabled to perform telephone functions independently of the computer, but is reliant upon cooperation with the computer in performing the particular telephone function. This is not anticipated by the teachings of Bentley et al. Moreover, Applicants assert that Bentley et al. does not render claim 1 obvious under Section 103.

The Abstract of Bentley et al. states, "A user is able to access any of the available telephony features from the telephone device at all times and from the computer when it is powered-on" (underlining added). The same statement is made in the Summary of the Invention in column 2, lines 21-24. For both locations of the statement, the following sentence states that the telephony features which can be accessed at all times from the telephone device include Caller ID information, call screening, and an integrated telephone answering system which provides for reception, transmission and storage of voice, facsimile and electronic mail messages. Since the Bentley et al. patent teaches that the telephone is able to access any of the telephony features, the patent does not present a *prima facie* case with regard to anticipation under Section 102, as applied to the amended claim. Additionally, since the patent teaches that the telephony features which are accessible by the telephone device while the computer is powered-off have a high level of sophistication (e.g., facsimile capability and electronic mail capability), the patent does not render it obvious to modify its teachings to rely upon the processing capabilities of the computer.

As previously noted, amended claim 1 is a combination of previous claim 1 and now-cancelled claim 7. As a result, the amended claim

includes one set of steps regarding storing received call-related data and a separate set of steps regarding processing call-related data. In comparing the storage-determination set of steps, the Office action cited Fig. 4 of Bentley et al. and column 27, lines 8-17. Then, when referring to the processing-determination set of steps, the Office action again relied upon the teachings of Bentley et al. regarding storage determinations. Applicants recognize that in the determination of patentability of pending claims, the claims are to be given their broadest reasonable interpretation. However, the claims must be interpreted in a manner consistent with what would be understood by a person of ordinary skill in the art. Since amended claim 1 includes the description of the storage-determination set of steps and the description of the processing-determination set of steps, it is asserted that a person of ordinary skill in the art would not interpret the claim such that the same storage capability of Bentley et al. would read upon both sets of steps. It follows that the amended claim is not anticipated, taught or suggested by the Bentley et al. patent.

Moreover, in addressing the processing-determination set of steps of original claim 7, the Office action referred to the teachings of Bentley et al. relating to Caller ID information, which is enabled by the telephone without reliance upon cooperation with the computer. Bentley et al. specifically states that the telephone device is able to capture any calls and keep Caller ID information, even if the computer is not available (Bentley et al.: column 27, lines 8-12). Because the telephone device of Bentley et al. is not reliant upon cooperation with the computer in performing any telephone function, Bentley et al. does not anticipate amended claim 1. Moreover, the Bentley et al. patent does not render it obvious to modify the prior art method to more closely approach the invention described in pending claim 1.

Reconsideration of claim 1 in view of the amendment is respectfully requested.

2. Patentability of Independent Claim 17

Independent claim 17 describes a method that is directly and consistently specific to processors and data processing. Applicants respectfully assert that a person of ordinary skill in the art would not consider the teachings of Bentley et al. regarding the overflow transfer of data for storage at the computer to be the “processing” of independent claim 17. In the claimed invention, the steps include (1) enabling a first processor resident in a telephone to process data received at the telephone, (2) enabling a second processor resident in the computer to process data received at the telephone, (3) receiving call-related data at the telephone, (4) recognizing that the call-related data received at the telephone requires further processing, (5) determining whether the call-related data will be processed using the first processor or the second processor, and (6) processing the call-related data in either the telephone or the computer based upon the determination step.

As previously noted, Applicants recognize that claims are to be given their broadest reasonable interpretation, but the courts are unanimous in holding, “The terms in a claim are given their ordinary meaning to one of skill in the art unless it appears from the patent and file history that the terms were used differently by the inventors.” Intellicall Inc. v Phonometrics Inc., 21 USPQ2d 1383 (Fed. Cir. 1992). In claim 17, it is recognized that the call-related data requires further processing and a determination is made as to whether the data will be processed in the first processor of the telephone or the second processor of the computer. On the basis of the determination, the data is processed in either the telephone or the computer. In rejecting claim 17, it is noted that Bentley et al. teaches recognizing when the level of information stored in the telephone device exceeds a predetermined level, such as fifty percent of memory capacity. If the level is exceeded, the information from the telephone device is transferred to the computer for storage. However, a person of ordinary skill in the art would not interpret these teachings of Bentley et al. to be a recognition that call-related data requires further processing and to then determine whether the processing should occur at the telephone or the computer.

If, as proposed in the Office action, the "recognizing step" of claim 17 is anticipated by the Bentley et al. recognition that the predetermined level has been exceeded (e.g., fifty percent of memory capacity), the Bentley et al. method does not proceed to a step of determining whether the call-related data will be processed in the first processor of the telephone or the second processor of the computer. More clearly, the call-related data of Bentley et al. is not then processed in the telephone or the computer on the basis of the determination. Rather, Bentley et al. teaches that if it is recognized that the predetermined level has been exceeded, the transfer is initiated. Briefly, this automated transfer does not anticipate determining whether the call-related data will be processed using the processor of the telephone and then executing the processing accordingly.

Applicants respectfully request reconsideration of the claims in view of the amendments and remarks made herein. A notice of allowance is earnestly solicited. In the case that any issues regarding this application can be resolved expeditiously via a telephone conversation, Applicants invite the Examiner to call Thomas George at (650) 694-5191.

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Respectfully requested,

SIEMENS CORPORATION
Intellectual Property Department
170 Wood Avenue South
Iselin, New Jersey 08830
ATTENTION: Elsa Keller, IP Department
Telephone: (732) 321-3026

By: Thomas George
Thomas George
Registration No. 45,740
Attorney for Applicants
Tel: 650-694-5191
Fax: 650-968-4517